

Application no. 09/645,805
Amdt. dated Oct. 27, 2005
Reply to Office Action of July 27, 2005

REMARKS/ARGUMENTS

A. INTRODUCTION

In the Office action of July 27, 2005:

- Claims 1-3, 5-6, 12 and 14 were rejected under 35 USC § 103(a) as being unpatentable over the combination of Gibbons et al. (US Patent No. 5,305,020) and Parsons et al. (US Patent No. 5,133,048)
- Claims 4 and 7 were rejected under 35 USC § 103(a) as being unpatentable over Gibbons and Parson, and further in combination with Sanchez et al. (US Patent No. 5,784,177);
- Claim 13 was rejected under 35 USC §103(a) as being unpatentable over Gibbons and Parsons, and further in combination with Katahira (US Patent 6,624,418); and
- Claims 8-11 were rejected under 35 USC §102(b) as being anticipated by Parsons (US Patent No. 5,133,048).

B. REJECTION UNDER 35 USC § 102(b)

Applicant submits that claims 8-11 of the present application are *patently distinguishable* with respect to Parsons because the reference fails to disclose that the information provided by the user interface is a visual image of the paper, rather than an iconic representation of the paper. Applicant, for example, discloses "the loader could select a piece of paper . . . and scan it The loader would select that option place the paper down . . . and the system would scan the paper This would then provide the information about the paper" (Specification pg. 4, lines 18 to 24, emphasis added) The Applicant further discloses that the "user scans a piece of the paper to be loaded This will create an image of the paper The printing device user interface would then be updated to include the scanned image The user interface would ☐ include an image of the paper" (Specification pg. 5 lns. 13-20, emphasis added) Through the visual image, e.g., scanned image, the visuals characteristics of the surface of the paper, e.g., letterhead symbols and/or color, are provided to the user (Specification pg. 4 lines 1-5) as claimed in claims 8-11.

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In contrast, the Office action states that Parsons disclosed in Fig. 9 “a view of paper having a surface 170 with the characteristics of the surface of the paper such as the color “white” and size “8.5x11” and in Fig. 10 “the window for viewing the size of a per “175-2,” the type of a paper “178-1” and the color of paper “180-1” (col. 6, lines 47-58). Applicant respectfully submits that Parsons did not disclose a visual image of the surface of the paper, but rather Parsons disclosed providing users with a symbolic representation of the paper, particularly by using icons. In fact, Parsons identified them with the term “icons” several times in the disclosure (e.g., col. 6 lns. 28-36) and in Figs. 9 and 10. Thus, in viewing the color of the paper, for example, Parsons disclosed providing an iconic view of the color of the paper, including a label, while the Applicant’s specification discloses seeing the visual image, e.g., scanned image, of the color characteristic.

The Office action further states that the “color of paper in Parsons is actual color and the current status of characteristics of the paper is displayed in the user interface in visual form” (page 11, lns. 13-17). The Applicant has amended the claim to clarify that the visual form is a view that comprises a visual image rather than just iconic representation of the actual color of the surface of the paper, as explained in this section.

As to claim 9, the Office action also stated that “Parsons further teaches the characteristics comprises a template (Please see figure 10 where the pattern of any of objects is displayed on the window would be considered as a template; or col. 7, lines 21-23.)” The cited lines and column state that “[o]rdered stock may comprise any set of successively different or unique sheets of print media that forms a repetitive pattern or set” (emphasis added). Furthermore, Parsons stated that “Fig. 13, is a ‘rainbow’ set . . . consist[ing] of 7 different colors.” The Office action further stated that based on the cited lines and column, “each sheet pattern would be a template.” Applicant respectfully submits that the Examiner has a different definition of template compared to what is disclosed in Applicant’s application. Applicant in his disclosure has used templates, for example, “templates for standardized forms” (pg. 4, ln. 14), “a thumbnail . . . of the paper, or a template,” (pg. 5, lns. 3), and “[t]emplates would typically [be] used for such things as forms” (pg. 5, lns. 3-4). Templates as disclosed by the applicant are

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not various sheets or successive unique sheets forming a repetitive pattern, but rather as templates, related to forms, letterheads, etc. Furthermore, claim 9 depends on claim 8 and incorporates elements similar to claim 8. For these reasons, the Applicant respectfully submits that claim 9 is allowable.

As to claims 10 and 11, they depend on claim 8 and should be found allowable for the same reasons discussed in this section.

As to claim 11, which depends on claim 8, the Office action stated that "the form of the ordered-sheet set '215 in fig. 13' would be considered as a thumbnail." Applicant submits that the original claim 11, used 'thumbnail' as "thumbnail of a piece of the paper." Thumbnail was also used in the specification as "thumbnail sketch of the paper, or a template" (pg. 5 ln. 4). Claim 11 was previously amended to say "thumbnail image." Applicant submits that the Examiner has improperly construed "thumbnail." Consistent with the Applicant's use of thumbnail, the American Heritage® College Dictionary, fourth edition, defines a thumbnail as "a reduced image of a graphic or document page, used in order to view multiple images on a screen simultaneously or to download such images more rapidly." Applicant respectfully submits that our use of the term "thumbnail" is consistent with the specification and the plain and ordinary meaning and is different from the Examiner's. Accordingly, the Applicant requests allowance for this claim.

Based on the reasons discussed in this section, the Applicant respectfully submits that claims 8 through 11 are patentably distinguishable over the prior art and an allowance of these claims is respectfully requested.

C. REJECTION UNDER 35 USC § 103(a)

Applicant submits that claims 1-3, 5-6, 12, and 14 are nonobvious over the combination of Gibbons and Parsons; claims 4 and 7 are nonobvious over the combination of Gibbons and Parson, and further in combination with Sanchez; and claim 13 is nonobvious over the combination of Gibbons and Parson, and further in combination with Katahira.

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As to amended claim 1, the Applicant respectfully submits that Gibbons does not teach the step of "providing information about the preprinted characteristics of the paper." Applicant's specification states that:

"This user interface is an example of one that takes information related to the visual contents of the paper and provides it to the user. Again, as used here the visual contents or characteristics refer to the characteristics of the surface of the paper, such as letterhead symbols, These are different from the physical characteristics of the paper such as its size or orientation." (Specification pg. 4 lns. 1-5).

The Applicant's specification further discloses an example of a visual characteristic, which includes "pre-printed information like a letterhead." (Specification pg. 2 lns. 6-8). The Applicant also discloses that the "information provided may be . . . an identification of a template or form." (Specification pg. 2 lns.16-17). Furthermore, *templates* may be for standardized forms (specification pg. 4 line 14 and pg. 5 lns. 3-4).

The Office action cited col. 6 lines 14-15 and table 2 in col. 6 stating that "the type and size of the paper would represent for the surface of the paper and characteristics of the surface of the paper." The Applicant respectfully submits that the characteristics disclosed in Gibbons are fundamentally different and distinct from those disclosed by the Applicant. Furthermore, Applicant submits that the Examiner has missed or misread the distinction provided by the Applicant — i.e., visual characteristics are distinct from physical characteristics, e.g., size and orientation. (Specification pg. 4, lns. 1-5) (An applicant may be his own lexicographer. MPEP §2173.01.)

Gibbons further disclosed information about thermal transfer printing. (Col. 1 lns. 7) In its background section, Gibbons disclosed that "thermally transferred ink adheres better and more completely to a smooth print medium surface than to a rough surface such as that commonly found in plain paper. Therefore, specially coated paper is typically used in thermal transfer printers to improve the image quality and durability of printed images." (Col. 1, lns. 35-42).

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Because Gibbons was addressing thermal printing, Gibbons disclosed paper types related to that art. In particular, Gibbons provided information about the physical characteristics of paper, particularly type and size, but not visual characteristics, as defined by the Applicant, much less preprinted characteristics as claimed in claim 1. Furthermore, although Gibbons mentioned different media types, Gibbons again mentioned physical characteristics, i.e., paper with different sizes, e.g., A, A4, A perforated, and A4 perforated (Table 2, Col., 6, lns. 15-17) and media type that are "plain paper, coated paper, and transparency film." (Col. 8, lns. 61-63). In sum, Gibbons disclosed paper or media type being coated or not, but failed to suggest or disclose visual characteristics. Similar to Gibbons, Parsons also did not disclose, suggest, teach, or even hint about providing information pertaining to preprinted characteristics of paper. For the above reasons, the Applicant respectfully request that claim 1 be allowed.

As to claims 2, 3, 4, 5, 6, and 7, these claims depend on claim 1 and thus incorporate similar features to that of claim 1 with further clarification and/or limitation. Applicant therefore submits that these claims are novel and nonobvious and therefore should also be allowable.

As to claim 12, claim 12 has been amended to "receive information about the visual image characteristics of a surface of a paper." Amended claim 12 is similar to amended claim 8. Gibbons, as discussed in section B above, and Parsons, whether taken individually or in combination, do not teach, suggest, or even hint about displaying a visual image of the surface of the paper. One of the tenets of patent law states that "the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." MPEP §2141. Gibbons in combination with Parsons do not teach the visual image characteristics, and thus claim 12 should be allowed.

Because claims 13 and 14 depend on claim 12, they incorporate similar features to that of claim 12, with further clarification and/or limitation. Applicant submits that these claims should also be allowed.

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D. NEW CLAIMS 15 TO 26

Applicant respectfully submits new claims 15 to 26. No new matter has been introduced and all claims are supported by the Applicant's specification.

E. CONCLUSION

For all the forgoing reasons, Applicant submits that ALL claims be allowed. Furthermore, no new matter has been added by the amendments. No new search is also required. Should there be any other fees due for this action, your office is authorized to draw from the firm deposit account number 023979. Should you have any questions, or identify any problem, I would appreciate a telephone call so that this matter may be resolved promptly.

Respectfully submitted,

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